

Remarks

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1 and 8 have been amended. Support for the amendment can be found, at least, on page 8, lines 18-22 and page 10, lines 3-30 and particularly lines 4-8 and 25-26 of the specification as originally filed. Claim 21 was previously cancelled. No new claims have been added. No new matter has been added. Accordingly, Claims 1-20 (20 claims) will be pending in the present application upon entry of this Reply and Amendment.

A detailed listing of all the claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 103

On pages 2-8 of the Office Action, the Examiner has rejected Claims 1-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Haseltine et al. (US Patent No. 6,578,015) ("Haseltine") in view of Hutchison et al. (US Patent Pub. No. 2005/0192896) ("Hutchison").

Haseltine discloses a biller-centric service provider which is stated to be applicable to consolidators, but in fact is little more than a bill service provider (BSP) for multiple billers. Haseltine receives bills directly from billers (see col. 4, lines 52-57). In the biller-centric approach of Haseltine, bills from multiple billers are delivered to a service provider having a single website, to be presented to the customers of the billers being serviced in a manner which preserves the "look and feel" of the billers' paper bills (see col. 5, lines 7-25).

The Examiner states "Haseltine does not explicitly teach the features of allowing billers to review and obtain reports after authentication of the merchant identification

number as recited in the claims; and authorization to access said data base provided by a credit verifier." (Office Action, page 3)

The Examiner further states that "Hutchison teaches a closed system comprising a register merchants and consumers in which parties are identified and authenticated to insure security (Abstract, paras. 0013, 00148 "*merchant authenticator component*"); and authorizing access to said data base by a credit verifier (para. 0094). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Haseltine to include this step as taught by Hutchison. One would have been motivated to prevent unauthorized access to said data base and for account creation purposes respectively." (Office Action, page 3)

Claim 1 of the present application is in independent form and recites an "electronic bill presentment and payment system" comprising, in combination with other elements,

" a portal interface element configured by an individual consumer as a secure personalized portfolio for reviewing and paying electronic bills coupled to said database, the portal interface is accessed and viewed by the consumer on any device in any location in actual, electronic or virtual space, using any network or communication system, said portal interface element configured to access a plurality of visual interfaces each associated with a different web portal or bill presentment and payment website, each visual interface being associated with a web portal or bill presentment and payment website different from other of said visual interfaces, each of said visual interfaces configured to allow the consumer to review and pay said consumer's bills and thereby change information in said database with the secure personalized portfolio only if said consumer has been authorized to access said database by a credit verifier."

Claims 2-7 depend from independent Claim 1.

Claim 8 of the present application is in independent form and recites an "electronic bill presentment and payment system" comprising, in combination with other elements,

"a portal interface element configured by an individual consumer as a secure personalized portfolio for reviewing and paying electronic bills coupled to said database, the portal interface is accessed and viewed by the consumer on any device in any location in actual, electronic or virtual space, using any network or communication system, said portal interface element configured to allow access to a plurality of visual interfaces each associated with a different web

portal or bill presentment and payment website, each visual interface being associated with a different web portal or bill presentment and payment website from other of said visual interfaces"

Claims 9-20 depend from independent Claim 8.

Each of the independent claims (1 and 8) of the present application require a "portal interface element configured by an individual consumer as a secure personalized portfolio for reviewing and paying electronic bills ... the portal interface is accessed and viewed by the consumer on any device in any location in actual, electronic or virtual space, using any network or communication system ..." as supported in the Specification as originally filed at least on page 8, lines 11-25 and page 10, lines 3-30 of the Specification and illustrated in Fig. 3.

The "electronic bill presentment and payment system" recited in independent Claim 1 and the "electronic billing presentment and payment system" recited in independent Claim 8 would not have been obvious in view of Haseltine alone or in any proper combination with Hutchison under 35 U.S.C. § 103(a). Haseltine, alone or in any proper combination with Hutchison, does not disclose, teach or suggest a "system" comprising, in combination with other elements, "a portal interface element configured by an individual consumer as a secured personalized portfolio for reviewing and paying electronic bills ... the portal interface is accessed and viewed by the consumer on any device in any location in actual, electronic or virtual space, using any network or communication system ..."

To transform the "methods, devices and systems for electronic bill presentment and payment" of Haseltine and the "method and apparatus for ordering goods, services and content over an internet work using a virtual payment account" of Hutchison into the systems as recited in independent Claims 1 and 8 would require still further modification, and such modification is taught only by the Applicants' own disclosure. The combination of Haseltine and Hutchison, as suggested by the Examiner, does not teach all of the elements of independent Claims 1 and 8 of the present application.

Applicants submit that Haseltine teaches a bill presentment and payment system that preserves the "look and feel" of the billers' paper bills as described above. More specifically, Haseltine teaches that the customer 390 may log onto a website of a biller 330 using the commerce servers on the web. Popular web browsers such as Netscape Navigator® (see col. 9, lines 52-60). Haseltine further teaches that the customer 380 may log onto the internet website maintained by the thin consolidator 360 and in so doing, the biller's corporate identities, as embodied by the look and feel of their bills, may be preserved at the thin consolidator's 360 cite, as rendered by the customer's 380 web browser software (see col. 10, lines 48-58). In other words, Haseltine does not teach a "portal interface element configured by an individual consumer as a secured personalized portfolio for reviewing and paying electronic bills" of the consumer. Haseltine teaches that the consumer or customer must use either the biller's website or navigate through general commercial web browsers or websites of a consolidation rather than a portal interface element configured by an individual consumer as a "secure personalized portfolio related to a specific consumer" as disclosed and claimed in the present application.

The Examiner cites Hutchison for providing a "merchant authenticator component." Hutchison also teaches that a consumer uses a consumer computer 50 that includes program code and data necessary for ordering and paying for a product over the internet 40 in accordance with the present invention. More specifically, the memory 63 stores a web browser component 64, such a Netscape's Navigator® or Microsoft's Internet Explorer® browsers (para. 0046 of Hutchison). Hutchison further teaches in para. 0048 that a consumer may use a commerce engine component 75 of an existing commerce engine, such as Microsoft® Site Server which allows for payment of products ordered over the internet.

Applicants submit that neither Haseltine nor Hutchison teaches a "portal interface element configured by an individual consumer as a secure personalized portfolio for reviewing and paying electronic bills ... the portal interface is accessed and viewed by the

consumer on any device in any location in actual, electronic or virtual space, using any network or communication system" as requires in each of independent Claims 1 and 8 of the present application.

Haseltine and Hutchison teach the use of either biller's websites having the look and feel of the biller's paper bills or using bill consolidation using "off the shelf" web browsers. Further, neither Haseltine nor Hutchison teach or even hint at an individual consumer configuring a "portal interface as a secure personalized portfolio for reviewing and paying electronic bills" of that consumer. Both Haseltine and Hutchison teach away from using a " consumer configured portal interface element configured as a secure personalized portfolio ..." by using a biller's website or bill consolidator commercial browser to have consumers pay their bills. Accordingly, one ordinarily in the art would not be compelled to combine Haseltine and Hutchison, and more specifically even if Haseltine and Hutchison were combined, as suggested by the Examiner, it would not result in that which is disclosed and claimed in the present application since there is no teaching in either reference for a consumer configuring a portal for their own use.

The Examiner is expected to make the factual determinations set forth in Graham vs. John Deere Company, 383 US 1, 17, 148 USPTO 459, 467 (1966), and to provide a reason why one having ordinarily skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Recently, the Supreme Court weighed in on the issue of obviousness and noted that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The quote specifically stated:

Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there is an **apparent reason** to combine the known elements in a fashion claimed by

the patent at issue. To facilitate their view, this analysis **should be made explicit.**

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 127 S. Ct. 1727 (2007). Emphasis added.

Therefore, in formulating the rejection under 35 U.S.C. §103(a) based on a combination of prior art element, it remains necessary to explicitly identify the reason why a person or ordinary skill in the art would have combined the prior art elements in the manner claimed. In the December 8, 2009 Office Action, the Examiner states at page 3 and 4 "It would have been obvious to one of ordinarily skill in the art at the time o (sic) the invention to modify Haseltine to include the step as taught by Hutchison. One would have been motivated to do so to prevent unauthorized access to said database and for account creation purposes respectively." The step taught by Hutchison, as identified by the Examiner, is "a closed system comprising registered merchants and consumers in which parties are identified and authenticated to insure security ... and authorizing access to said database by a credit verifier ..." None of these statements or motivations address the "portal interface element configured by an individual consumer" required in the present application.

Applicants submit that such reasoning and statement of motivation in the Office Action is not the finding justifying the combination of Haseltine and Hutchison in accord with the Court's stated requirements described above. Such statement of combination and motivation does not address the element in the present application of "a portal interface element configured by an individual consumer as a secured personalized portfolio for reviewing and paying electronic bills coupled to said database, the portal interface is accessed and viewed by the consumer on any device in any location in actual, electronic or virtual space, using any network or communication system" required in each of independent Claims 1 and 8 of the present application.

Applicants submit that Haseltine teaches that the customer uses the biller's website or uses a biller's consolidator (see above) and Hutchison teaches the use of existing

commerce engines such as Microsoft® site service or Visa® or Mastercard® gateways. The combination of the cited prior art and the alleged motivation as asserted by the Examiner is not like the analysis required by the Supreme Court in KSR; rather, this is an argument that the absence of several elements of the claimed invention in the Haseltine reference makes it obvious to add those elements since they are (incorrectly) alleged to be found in an unrelated reference, namely the Hutchison reference. This is clearly not the analysis required by KSR; there is neither the explicit analysis required by KSR nor the identification of apparent reasons to make the combination. In fact, Applicants submit that the combination of Haseltine and Hutchison as asserted by the Examiner does not address the portal interface element configured by an individual consumer limitation of each of independent Claims 1 and 8 of the present application. The combination of prior art references must teach or suggest all of the elements of the present claims in order to establish a *prima facie* case of obviousness.

The Graham and KSR cases require that the Examiner initially resolve three questions of fact: (1) determine in the scope and contents of the prior art; (2) Ascertaining the differences between the claimed invention and the prior art; and (3) establishing the level of ordinary skill in the pertinent art. Only then can it be determined whether or not claims are obvious in the view of the prior art. The scope and content of the prior art has clearly not been properly determined by the Examiner. An examination of the Office Action will reveal that there is not a single word relating to the establishment of the level of ordinary skill in the pertinent art. The rejections have clearly failed to meet the requirements of the Supreme Court. As such, the Examiner's comments continue to fail to make the findings required by KSR and 35 U.S.C. §103(a). Since a proper and logically valid analysis is clearly not been performed, Applicants respectfully solicit the removal of §103(a) rejections of independent Claims 1 and 8, and the allowance of these claims as well as the claims dependent therefrom.

The systems recited in independent Claims 1 and 8, considered as a whole, would not have been obvious in view of Haseltine and/or Hutchison. The rejection of Claims 1

and 8 over Haseltine in view of Hutchison under 35 U.S.C. §103(a) is improper. Therefore, independent Claims 1 and 8 are patentable over Haseltine in view of Hutchison.

Dependent Claims 2-7 which depend from independent Claim 1 and dependent Claims 9-20 which depend from independent Claim 8 are also patentable. See 35 U.S.C. §112, para. 4. Applicants respectfully request withdrawal of the rejection of Claims 1-16 and 18-20 under 35 U.S.C. §103(a).

On page 9 of the Office Action, the Examiner has rejected Claim 17 under 35 U.S.C. §103(a) as being unpatentable over Haseltine in view of Hutchison and further in view of Kamen et al. (US Patent No. 6,421,067).

In response, the Applicants submit that Claim 17 depends from independent Claim 8. Since Applicants believe that independent Claim 8 is patentable over the combination of Haseltine and Hutchison, and that Kamen does not supply that which is missing in Haseltine and Hutchison, then dependent Claim 17 is also patentable. (See 35 U.S.C. §112, para. 4). Accordingly, Applicants respectfully request that the Examiner withdraw his rejection of Claim 17 under 35 U.S.C. §103(a).

Response to Arguments

On pages 9 and 10 of the Final Office Action, the Examiner comments with respect to Applicants' previous arguments filed on August 12, 2009. Applicants submit that their response to the Examiner's comments and their response to arguments section are addressed above and that Examiner has not provided a *prima facie* case of obviousness since the Examiner has not identified all the elements of independent Claims 1 and 8 in the prior art and therefore has not provided a *prima facie* case of obviousness. Further, Applicants submit that the proper standard for establishing a *prima facie* of obviousness is set forth in the Graham and KSR Supreme Court cases as discussed above.

* * *

It is submitted that each outstanding objection and rejection to the application has been overcome, and that the application is in condition for allowance. The Applicant requests consideration and allowance of all pending claims (Claims 1-20).

The Examiner is invited to contact the undersigned by telephone is it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted:

BY /James A. Wilke/
James A. Wilke
Attorney for Applicant
Registration No. 34,279

Reinhart Boerner Van Deuren s.c.
1000 North Water Street, Suite 2100
Milwaukee, WI 53202

(414) 298-8383

Customer No. 22922